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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,484	09/07/2001	Wen-Sung Tsai	CEIP0027USA	4155
27765	7590	08/25/2004	EXAMINER	
NAIPO (NORTH AMERICA INTERNATIONAL PATENT OFFICE) P.O. BOX 506 MERRIFIELD, VA 22116			NGUYEN, MAIKHANH	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/682,484	<b>Applicant(s)</b> TSAI, WEN-SUNG	
	<b>Examiner</b> Maikhanh Nguyen	<b>Art Unit</b> 2176	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. This action is responsive to the following communication: original application filed 09/07/2001.
2. Claims 1-8 are currently pending in this application. Claim 1 is independent claim.

***Foreign Priority***

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Taiwan on 03/30/2001. It is noted, however, that applicant has not filed a certified copy of the 090107623 application as required by 35 U.S.C. 119(b).

***Claim Objections***

4. Claim 7 is objected to because of the following informalities: "an internet" (claim 7) should probably read "an Internet". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites “a picture image” (line 5) is indefinite, because it is unclear which picture image is referring to.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant

**Admitted Prior Art (APA)** in view of **Park** (U.S. 6,374,245 – filed 03/1998).

As to independent claim 1, APA teaches (*Fig. 1*) a personal data assistant (*PDA 10; para.0006*) connected to a server (*the computer 40; para.0007*), the server having a plurality of application programs (*the computer 40 comprises a plurality of application program 44; para.0007*) the PDA comprising:

- a housing (*a housing; para.0006*);
- a memory installed in the housing for storing programs and data (*a memory 14 for storing application programs 16 and files 18; para.0007*);
- a processor electrically connected to the memory for executing the programs stored in the memory (*a processor 20 electronically connected to the memory 14 for executing the application programs 16; para.0007*);
- a display panel installed on the housing for displaying data (*a display panel 22 installed on the housing 12; para.0006*); and
- an input device for inputting data (*an input device 24; para.0006*);

wherein the PDA is capable of sending a file to the server (*e.g., the file is sent 'uploaded' to the computer 40 from the PDA; para.0008*), the server then opening the file using a corresponding application program (*e.g., the file is opened by a corresponding application program 44; para.0008*), and sending a picture image of the opening file back to the PDA (*e.g., the updated file is download from the computer 40 back to the PDA; para.0008*).

APA teaches the file is sent (*upload*) from the PDA to a computer 40 (*server*) and the updated file is downloaded from the computer 40 (*server*) back to the PDA (*para.0008*). Therefore, the PDA must be connected to the computer 40 (*server*) via a network for performing the uploading and downloading files.

APA, however, is silent on a network. Park teaches a PAD connected to a server to a server via a network (*see Abstract / col.1, lines 15-18 and Fig.2*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Park in the system of APA because it would have provided the capability for facilitating the communication between the PDA and the server, and more particularly, for uploading files from PDA to the server and downloading the file back to the PDA from the server.

**As to dependent claim 2**, APA teaches the PDA and the server each comprise a data transceiving module, the file being sent from the data transceiving module of the PDA to the data transceiving module of the server so that the server is capable of opening the file (*para.0008*).

**As to dependent claim 3**, APA teaches when the server opens the file, the server will transmit the picture image via the data transceiving module of the server to the data transceiving module of the PDA so that the display panel is capable of displaying the opened file (*para.0008*).

**As to dependent claim 4**, APA teaches the server opens the file, a user is capable of using the input device to enter a user instruction, the user instruction being transmitted from the data transceiving module of the PDA to the data transceiving module of the server so that the server is capable of executing the user instruction, and then the server transmitting a picture image generated by executing the user instruction to the data transceiving module of the PDA from the data transceiving module of the server so that the display panel is capable of displaying the picture image (*para.0006 and para.0008*).

**As to dependent claim 5**, APA teaches a user is capable of using the input device to enter a file back instruction, the file back instruction being transmitted from the data transceiving module of the PDA to the data transceiving module of the server, when receiving the file back instruction, the server transmitting the file back to the PDA via the data transceiving module of the server back and the data transceiving module of the PDA (*para.0006 and para.0008*).

**As to dependent claim 6**, APA teaches a user is capable of using the input device to enter a file close instruction, the file close instruction being transmitted from the data transceiving module of the PDA to the data transceiving module of the server so as to make the server close the file (*para.0006*).

7. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant **Admitted Prior Art** (APA) in view of **Park** and further in view of **Jakobson** (U.S. 6,697,838 – filed 03/1998).

**As to dependent claim 7**, the combination of APA and Park does not explicitly teach “the network is an internet.”

Jakobson teaches the network is an internet (*col.5; lines 49-53*).

It would have obvious to a person of ordinary skill in the art at the time the invention was made to combine Park's teachings in the system of APA as modified by Jakobson because it would have provided the capability for facilitating the communication between the PDA and the server, and more particularly, for uploading files from PDA to the server and downloading the file back to the PDA from the server.

**As to dependent claim 8**, the combination of APA and Park does not explicitly teach "the memory is a flash memory."

Jakobson teaches the memory is a flash memory (*flash memory; col.5, lines 50-56*).

It would have obvious to a person of ordinary skill in the art at the time the invention was made to combine Park's teachings in the system of APA as modified by Jakobson because it would have provided the capability for storing data, more particularly, for enabling the PDA to support new protocols as they become standardized.

### **Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Traversal et al.	U.S Patent No. 6,161,125	issued: Dec. 12, 2000
Kammer et al.	U.S Patent No. 6,363,082	issued: Mar. 26, 2002
Ma	Patent Application Publication No. 6,363,082	issued: Jun. 13, 2002
Huang et al.	U.S Patent No. 6,477,543	issued: Nov. 5, 2002
Hiscock et al.	U.S Patent No. 6,721,787	issued: Apr. 13, 2004

Hiscock et al. U.S Patent No. 6,721,787 issued: Apr. 13, 2004

Richard Comerford, "Handhelds duke it out for the Internet", IEEE Spectrum, August 2000, pp. 35-41.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. After mid-October, 2004, the examiner can be reached at (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (703) 305-9792.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen  
August 21, 2004

  
SANJIV SHAH  
PRIMARY EXAMINER